



Attorney Docket: 009523-0283651
Client Reference: OL97501N-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: NISHIOKA . Confirmation Number: 4064
ET AL.

Application No.: 09/957,471

Group Art Unit: 2873

Filed: September 21, 2001

Examiner: Evelyn Lester

Title: OPTICAL APPARATUS

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the one-month Office Action dated March 8, 2005, Applicant elects Species II, directed to claims 5, 21-26, 38 and 39, drawn to a variable optical characteristic optical element utilizing an electrostatic force or piezoelectric effect, for examination in the present application. This election is made with traverse.

It is respectfully submitted that the criteria for a proper restriction requirement set forth in MPEP § 803 has not been satisfied. In particular it is respectfully submitted that the search and examination of the entire application can be made without serious burden. It is respectfully noted that all of the species identified are classified in class 359, and that Species I, II and V are classified in subclasses 240, 245 and 244, respectively. It is respectfully noted that subclasses 245 and 244 are three dot and four dot subclasses indented under two dot subclass 240. As the two dot subclasses of the U.S. Patent Classification System are inclusive of the subject matter indented beneath them, the search and examination of subclass 240 would be required for the search and examination of the entire application. It is also respectfully noted that subclass 280 is defined in the U.S. Classification Manual as indented under subclass 240.

It is also respectfully noted that MPEP § 806.04(e) states: "Claims are definitions of inventions. *Claims are never species.* Claims may be restricted to a single disclosed embodiment (i.e. a single species, and thus be designated *a specific species claim*), or a claim

may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated *a generic or genus claim*). *Species are always the specifically different embodiments.* (Italic emphases in original; underlining emphasis added.)

The determination that the claims, and not the specifically different embodiments, define a plurality of species is clearly incorrect and contrary to PTO policy as set forth in the MPEP. Accordingly, the election of species requirement is incorrect and must be withdrawn.

Reconsideration and withdrawal of the election of species requirement is respectfully requested.

Respectfully submitted,

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Date: April 27, 2005
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